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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/753,163	01/02/2001	Robert C. Eisenman	RE-1	9699
34284	7590	06/06/2005	EXAMINER	
ROBERT D. FISH RUTAN & TUCKER LLP 611 ANTON BLVD 14TH FLOOR COSTA MESA, CA 92626-1931			LIEU, JULIE BICHNGOC	
			ART UNIT	PAPER NUMBER
			2636	

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

✓

<b>Office Action Summary</b>	<b>Application No.</b> 09/753,163	<b>Applicant(s)</b> EISENMAN, ROBERT C.	
	<b>Examiner</b> Julie Lieu	<b>Art Unit</b> 2636	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 2/02/05.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 26-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This office action is in response to Applicant's amendment filed February 02, 2005. No claims have been amended, canceled, or added.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Claim Rejections - 35 USC § 103***

3. Claims 26-32 are again rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. (US Patent No. 6,392,592) in view of Hoffman et al. (US Patent NO. 5,742,233).

##### **Claim 26:**

Johnson disclose a device, having a radio portion that communicates with a plurality of satellites for determining a location of the device comprising an apparatus for unlocking a door on nearby motor vehicle. Though Johnson is silent about the capability for triggering multiple warnings at different locations, including a first trigger that activates an alarm on the vehicle, it would have been obvious to one skilled in the art to include this capability in the key fob in Johnson because keyless entry and vehicle antitheft alarms capabilities incorporated in a single key fob is conventional in the art.

Johnson fails to disclose a second trigger that transmits the location to a recipient at distant location that communicates with a ground dispatch location. However, the use of a

Art Unit: 2636

personal locator is old in the art as taught in Hoffman et al. in which the device can be incorporated into a keychain, as admitted by applicant. Therefore, it would have been obvious to one skilled in the art to incorporate the Hoffman device into the remote control unit in Johnson because Johnson readily teaches to combine the vehicle remote control with a locator device within the same key chain for convenience.

Claim 27:

Though no connector for attachment of a key is shown since the Johnson's device is a key fob of which the remote control unit is contained, it would have been obvious to one skilled in the art to use a key connector for attachment of a key in remote control unit, which is separate from a key.

Claims 28-30:

It would have been obvious to one skilled in the art that the alarm is part of a security system of the motor vehicle in the modified system in Johnson wherein vehicle security alarm is used and some switches is used for activating and deactivating the alarm system.

Claim 31:

Johnson discloses using the same trigger to open the door and to send a signal to request a vehicle location indication. In light of this teaching, one skilled in the art would have readily recognized using the same trigger in Johnson and Hoffman to send both signals at the same time as desired. This feature only presents a choice in design as to how a signal would be activated.

Claim 32:

Johnson fails to discuss providing a sound when a switch is operated. However, it is conventional in the art to provide a sound to confirm an activation of the vehicle remote

Art Unit: 2636

function. Thus, one skilled in the art would have readily recognized using this feature in the combined system of Johnson and Hoffman because it is conventional in the art.

*Applicant's Remarks*

4. The applicant's has presented the following arguments:

The applicant has asserted that the examiner fails to establish the prima facie case of obviousness and has stated that there must be some suggestion or motivation, within the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings, and there must be a reasonable expectation of success. The applicant has further stated that pointing out that various element by themselves are known in the prior art is insufficient.

5. Applicant's arguments filed 02/02/05 have been fully considered but they are not persuasive.

The examiner submits that a prima facie case of obviousness is established when the teachings of the prior art would appear to have suggested the claimed subject matter to a person of ordinary skill in the art. The combined teachings of the prior art need not provide an absolute prediction of success for the claimed subject matter. Instead, only a reasonable likelihood of success is required. (In re Ball Corporation, 18 USPQ 2d 1491).

A skilled artisan would have readily recognized that by combining the devices of Johnson and Hoffman together a the same remote control housing would likely the desirable result of remote controlling the in-vehicle system and to transmit a signal to a remote monitoring location.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to one skilled in the art to integrate the two devices in the same vehicle remote control unit because the function of each of the devices would not thereby be modified. They are contained in the same housing just for convenience.

Therefore, the applicant's argument is not deemed persuasive.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

Art Unit: 2636

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie Lieu whose telephone number is 571-272-2978. The examiner can normally be reached on MaxiFlex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Hofsass can be reached on 571-272-2981. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Julie Lieu  
Primary Examiner  
Art Unit 2636

May 23, 05